

REMARKS

Applicants respectfully request entry of the remarks submitted herein. Claim 1 was amended herein, and new claims 21-30 were added herein. Support for the amendment to claim 1 and for new claims 21-30 can be found, for example, in Examples 1-16 in the specification. Specifically, see the Tables on pages 3, 4 and 5 of the published application. In addition, claims 2, 3 and 9-20 were canceled herein without prejudice to continued prosecution.

Claims 1, 4-8 and 21-30 are currently pending. Reconsideration of the pending application is respectfully requested.

The Claim Objections

Claims 4-6, 8, 10-12, 14, 16-18 and 20 stand objected to for failing to define the article. According to the Examiner, an "A" should be inserted at the beginning of each of those claims.

Without acquiescing to the Examiner's rejection, claims 10-12, 14, 16-18 and 20 have been canceled herein without prejudice to continued prosecution. Therefore, the objection to those claims is moot. With respect to claims 4-6 and 8, those claims are directed toward plural articles (e.g., tortillas, tortilla chips, taco shells). Therefore, it would be improper to include an "A" at the beginning of those claims. In view of the remarks herein, Applicants respectfully request that the objection to the pending claims be withdrawn.

The 35 U.S.C. §112 Rejections

Claims 1-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. According to the Examiner, the use of 'reduced effective' in claims 1 and 15 is indefinite because it is unclear what is being 'reduced' and by how much, and it is unclear what is 'effective' and for what purpose. OA at page 2.

Without acquiescing to the Examiner's rejection, Applicants have amended claim 1 to remove the reference to "reduced effective carbohydrates" in the preamble. Simply for completion, Applicants also have removed the reference to "high fiber" in the preamble of claim 1. As amended, claim 1 no longer contains relative terms such as "reduced" or "high". Applicants note, however, that claim 1, as amended, refers to an amount of "effective carbohydrates." "Effective carbohydrates" is a term of art, and Applicants respectfully refer the Examiner to paragraph [0023] of the published application, which provides a definition of "effective carbohydrates."

In view of the amendments and remarks herein, Applicants respectfully request that the rejection of the pending claims under 35 U.S.C. §112, second paragraph, be withdrawn.

The 35 U.S.C. §103 Rejections

Claims 1-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Jensen et al. (US Patent No. 5,928,701) in view of Heller (US Patent No. 5,332,594) and Zimmerman et al. (US 2002/0034571) and Chiang et al. (US Patent No. 6,491,959). Applicants respectfully traverse this rejection.

Claim 1 as amended and new claim 30 are directed toward recipes that were exemplified in the specification. Each of claims 1 and 30 require specific ingredients including masa corn flour, ground corn bran, pre-gelatinized flour and/or starch, ground corn germ, corn gluten meal, and vital wheat gluten or wheat protein isolate. In this rejection, the Examiner simply identified references directed toward food products (e.g., taco shells or tortilla chips) that include one or more of the claimed ingredients (e.g., corn masa or wheat gluten) and, usually, one or more similar, but not identical, ingredients (e.g., oat bran instead of corn bran, or corn protein isolate instead of wheat protein isolate). With respect to the claimed amounts of each ingredient, the Examiner also alleged that the "amounts can readily be determined by one skilled in the art following the guidance of the secondary references and through routine experimentation" depending on the desired nutrition, flavor and texture. (OA at page 5).

The Supreme Court stated, in *KSR Int'l Co. v. Teleflex Inc.* (127 S. Ct. 1727, 1741 (2007)), that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." In addition, the Federal Circuit also stated, in *Ruiz v. A.B. Chance Co.* (357 F.3d 1270, 1275, C.A. Fed. 2004), that, when

[M]aking the assessment of differences [between the prior art and the claimed subject matter], section 103 specifically requires consideration of the claimed invention 'as a whole'.... The 'as a whole' instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

The present case is analogous to *Ruiz*. The Examiner simply combined the references (i.e., Jensen et al., Heller, Zimmerman et al. and Chiang et al.) to allegedly arrive at the claimed composition, which is contrary to the Courts' instructions in *Ruiz* as well as the Supreme Court's instruction in *KSR*.

It is also well established that unsubstantiated assertions can not be used to support a rejection. *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 Fed. Cir. 2001 (the Office "must point to some concrete evidence in the record in support of [its] findings."). In addition, the Supreme Court stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*KSR* at 1727, quoting *In re Kahn*, 441 F.3d 997, 988 (Fed. Cir. 2006)) and urged that "this analysis should be made explicit" (*KSR* at 1742). In the present case, the Examiner's assertions regarding routine experimentation are conclusory and unsupported, which is improper according to *KSR* and *In re Zurko*.

Instead of considering the claimed composition as a whole, the Examiner has improperly broken down the composition into its individual parts. Further, the Examiner's assertion that one of skill would arrive at the claimed amounts by routine experimentation is conclusory and unsubstantiated. In the absence of an articulated reasoning based on a rational underpinning, the obviousness rejection appears to be based on improper hindsight analysis. In view of the amendments and remarks herein, Applicants respectfully request that the rejection of the pending claims under 35 U.S.C. §103 be withdrawn.

The Double-Patenting Rejection

Claims 1-20 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-20 of co-pending US Application No. 11/084,197. The Examiner noted that this is a statutory double-patenting rejection that cannot be removed with a Terminal Disclaimer.

Applicants respectfully submit that US Application No. 11/084,197 is now abandoned. Accordingly, Applicants submit that the double-patenting rejection under 35 U.S.C. §101 is moot.

CONCLUSION

Applicants respectfully request that claims 1, 4-8 and 21-30 be allowed. Please apply the fee for the enclosed Petition for Extension of Time and any other charges or credits to Deposit Account No. 52-2342.

Respectfully submitted,

Date: _____

11/25/09

Grace P. Malilay

Grace P. Malilay
Reg. No. 37,669

CARGILL, INCORPORATED
Law Department
P.O. Box 5624
Minneapolis, MN 55440-5624
Telephone No.: (952) 742-2561
Facsimile No.: (952) 742-6349